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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,797	12/03/2001	Gayle Marie Frankenbach	7656M	8555
27752	7590	04/21/2004	EXAMINER	
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			HARDEE, JOHN R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,797

Applicant(s)

FRANKENBACH ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-30, 32-36 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-30, 32-36 and 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-30, 32-36 and 42-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Part B of claim 25 appears to be a Markush group, although it is not couched in the alternative form. As the examiner understands this claim, any amount of solvent may be present as long as a bilayer modifier is present. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 26-30, 32, 33 and 43-48 are 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 803,498 in view of Keys, US 5,670,472 and applicant's admissions. See the composition at the top of p. 18. The EP does not disclose that the disclosed polyquaternary compound meets the bilayer limitations, but applicant's specification states at the top of p. 5 that the compounds of the Keys reference meet these limitations, and the compound of the examples in the EP read on those disclosed by Keys. The examiner takes the position that the alkoxylated diols are

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oily, polar and/or nonpolar and hydrophobic. The preferred chain length for diol T meets the recited limitation.

### ***Claim Rejections - 35 USC § 103***

5. Claims 26-30, 32, 33, 35, 36 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 803,498 in view of Keys and applicant's admissions. Claims 35 and 36 are not disclosed with sufficient specificity to constitute anticipation, however, it would have been obvious to make such a composition because the addition of di-long chain quats is disclosed at p. 10, lines 29+.

### ***Allowable Subject Matter***

6. Claims 34, 42 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the 112 rejection were overcome. Reasons are of record in the previous office action.

### ***Response to Arguments***

7. Applicant's arguments filed March 9, 2004 have been fully considered but they are not persuasive. Applicant argues that a 102 rejection cannot be made over a combination of references. This is not persuasive because secondary references may be used in a 102 rejection to further explain the disclosure of the primary reference. MPEP 2131.01. Use of applicant's admission is not hindsight. Where applicant has

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provided *no* structural limitations, the examiner has taken recourse to the specification to determine what sort of compounds might be suitable. applicant's compositions do not have to meet the limitation of less than 7.5% of solvent if a bilayer modifier is present. In any event, the cited example contains a bilayer modifier and 0% of solvent, meeting both limitations. While this compound is a diol, it meets the chain length and alkoxylation limitations. No modification of references is required, as all of the limitations are present within one document. There is every expectation of success, because the EP discloses clear fabric softening compositions.

8. This rejection contains grounds of rejection which were not prompted by applicant's amendments. Accordingly, it is NOT FINAL.

9. Any prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", is positioned above the printed name.

John R. Hardee

Primary Examiner

April 16, 2004